REMARKS

Claims 3 and 4 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed. Claim 3 has been amended to correct the typographical error such that the claim now correctly reads "ethylbenzene hydroperoxide". In view of this explanation, Applicants respectfully request that the rejection be withdrawn.

Claims 1-6 were rejected under 35 USC § 103(a), as obvious over Dubner et al US 5,210,354 ('354) in view of Joustra et al EP 0345856 ('856) or over the '856 reference in view of the '354 reference. This rejection is respectfully traversed.

To establish a *prima facie* basis for obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure [MPEP § 2142; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).]

Claim 1 has been amended to clarify that the phenyl alkanol or substituted phenyl alkanol product is crude – that is, it is not purified before being passed from step (a) to step (b). As explained in the specification on page 4, lines 17-28, the crude phenyl alkanol or substituted phenyl alkanol contains heavy components that are not removed.

The '354 reference is directed toward a process for removing the heavy components from the phenyl alkanol that is the product of the epoxidation reaction, whereas in the instant invention, the heavy components are specifically left in the product stream and passed to the dehydration step. The '856 reference is directed to an improved catalyst for the epoxidation reaction and does not address the dehydration reaction except in passing as part of an overall process.

Therefore, there is no suggestion or motivation in either reference to modify it in order to arrive at the instant invention. There would certainly be no expectation of success since the '354 reference requires the removal of the heavy components. Additionally, all the claim limitations are not found in the prior art.

In view of the above clarifications and arguments, Applicants believe a *prima facie* case for obviousness has not been made and respectfully request that the rejection be withdrawn.

Claims 1 and 3 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/601,049. A terminal disclaimer accompanies this Amendment. In view of this, Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

In view of the above amendments and remarks, Applicants believe the instant application to be in condition for allowance and respectfully request that such action be taken.

Respectfully submitted,

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